

REMARKS

Claims 1-113 were pending in the present application. Claims 54-86 are being cancelled without prejudice to filing same in a reissue continuation application. Claims 114-117 are being added. After entry of this Amendment, claims 1-53 and 87-117 will be pending.

The following remarks address the rejections of claims 1-113 as set out by Examiner in this Office Action.

Rejection of Claims 1-113 Based on the Reissue Declaration Submitted by Applicant

The Examiner has rejected claims 1-113 under 35 U.S.C. § 251 as being based upon a defective reissue declaration. More specifically, the Examiner has determined that the declaration submitted by Applicants on June 14, 2001 "is defective because it fails to identify at least one error which is relied upon to support the reissue application."

In response to the Examiner's concerns, the Applicant submits a new proposed declaration with this Amendment. As requested by the Examiner, the newly submitted draft declaration more specifically identifies that the at least one error being relied upon is that the patentee claimed less than he had the right to claim in the original '925 patent. For example, the newly submitted draft declaration indicates that the nature of broadening is the addition of method claims that are being added for the first time (MPEP 1412.03) in view of the previous patent Attorney's failure in the original application to appreciate the full scope of the invention. This error under 35 U.S.C. § 251 of failing to prosecute method claims is the at least one error that is being relied upon to support this reissue application.

This new declaration should overcome the Examiner's concerns. An executed version of the declaration will be forthcoming upon approval.

Rejection of Claims 8-113 as being Improper Recapture of Surrendered Matter

The Examiner has also rejected claims 8-113 under 35 U.S.C. § 251 as being an improper recapture of surrendered subject matter. In particular, the Examiner states that the pending claims "are directed to the similar limitations which were rejected and cancelled in the parent application 08/696,812." Further, the Examiner states that "the claims fail to include the limitations which were the reasons for allowance in the parent application 08/696,812."

Applicants have reviewed the pending claims with those prosecuted in the original application upon which the present reissue application is based.

Claims 8-53 and 99-113 of the present reissue application recite methods of supporting wireless communications via an inductive or magnetic field. Notably, the prosecution of the parent application (serial no. 08/696,812) included system claims only. Amendment of the apparatus claims in the original application did not result in surrendered subject matter with respect to method claims. Hence, the Applicant is not attempting to recapture subject matter that was surrendered during prosecution in the original application. Withdrawal of the rejection and further review of these method claims in light of this error under 35 U.S.C. § 251 is respectfully requested.

Although different in scope, independent claim 87 of the present application most closely parallels claim 4 of issued patent U.S. 5,912,925. No amendments or arguments of patentability were made by the Applicant with respect to claims 4-7 (in the '925 patent) during prosecution of the original application 08/696,812. Nor did the Examiner identify any reasons for allowance of claim 4-7 of the issued '925 patent. Thus, no identifiable subject matter was surrendered during prosecution and it is submitted that the breadth of claim 87 and corresponding dependent claims 88-98 of the instant application do not impermissibly attempt to recapture surrendered subject matter. Withdrawal of the rejection and further review of system claims 87-98 in light of the inadvertent error under 35 U.S.C. § 251 of claiming less than the patentee is entitled is respectfully requested.

New claims 114-117 even more clearly parallels original claim 4, so improper recapture also does not apply to this new set of claims.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned Attorney at (978) 341-0036.

Respectfully submitted,

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